

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte FIORENZA BERTIERI

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Appeal No. 2002-2307  
Application No. 29/105,570

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ON BRIEF

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Before COHEN, SMITH, and MOORE, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of the following design claim:

The ornamental design for an eyeglasses accessory as shown and described.

Appellant's eyeglasses accessory design is depicted in front elevational, front perspective, rear perspective, and cross sectional views in Figures 1 through 4, respectively.

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As evidence of obviousness, the examiner has applied the documents listed below:

Guthrie	1,959,915	May 22, 1934
Lin	5,485,227	Jan. 16, 1996
Shelton	Des. 373,782	Sep. 17, 1996

The following rejection is before us for review.

The design claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Shelton in view of Guthrie and Lin.

The full text of the examiner's rejection and response to the argument presented by appellant appears in the office action dated October 6, 2000 and the answer (Paper Nos. 10 and 15), while the complete statement of appellant's argument can be found in the main and reply briefs (Paper Nos. 14 and 16).

#### OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully considered appellant's specification, design claim, and drawing figures, the

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applied reference designs, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

We do not sustain the rejection of appellant's design claim for the reasons set forth below.

Pursuant to 35 U.S.C. § 171, one may obtain a design patent for "any new, original and ornamental design for an article of manufacture." To obtain such a patent, however, one must satisfy the patentability requirement of 35 U.S.C. § 103. See In re Borden, 90 F.3d 1570, 1574, 39 USPQ2d 1524, 1526 (Fed. Cir. 1996). In the design patent context, the ultimate inquiry under section 103 is whether the claimed design would have been obvious to a designer of ordinary skill who designs articles of the type involved. See In re Rosen, 673 F.2d 388, 390, 213 USPQ 347, 349 (CCPA 1982).

To combine prior art designs, one must first find a single reference, "a something in existence, the design characteristics of which are basically the same as the claimed design." In re Rosen, 673 F.2d at 391, 213 USPQ at 350. Once this primary

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reference is found, other references may be used to modify it to create a design that has the same overall visual appearance as the claimed design. See In re Harvey, 12 F.3d 1061, 1063, 29 USPQ2d 1206, 1208 (Fed. Cir. 1993). These secondary references may only be used to modify the primary reference if they are "so related [to the primary reference] that the appearance of certain ornamental features in one would suggest the application of those features to the other." In re Borden, 90 F.3d at 1575, 39 USPQ2d at 1526-27.

As can readily be discerned from appellant's drawing figures, the claimed eyeglasses accessory design reveals the visual prominent feature of the appearance of a particular pattern of holes across each of two transparent lenses.

As a basic reference, the examiner applied the Shelton design for a sunglass clip mechanism depicted in association with lenses shown in phantom lines (Fig. 1). According to the examiner (Paper No. 10), the Shelton design is similar in appearance to the claimed design except for the pattern of openings feature. To overcome the aforementioned deficiency, the

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designs of Guthrie and Lin are applied for their showings of a pattern of lens openings.

Clearly, the examiner's basic reference lacks appellant's ornamentally consequential feature of the appearance of a particular pattern of openings in transparent lenses of an eyeglasses accessory. As explained below, this panel of the Board does not view the respective designs of Guthrie and Lin as being suggestive of the modification proposed by the examiner. Unlike the now claimed design, Guthrie reveals the aesthetic feature of opaque discs (round configurations) with perforations. As to the Lin reference, it portrays the ornamental feature of a second (round) lens design 23 with apertures for association with a first lens design 22. As we see it, the particular and distinct design shown in each of Guthrie and Lin is not so related to the overall Shelton design that a designer of eyeglass accessories would have been motivated to modify the Shelton design, as proposed, to effect the now claimed design. It is for this reason that we cannot support the rejection on appeal.

In summary, this panel of the board has not sustained the rejection of appellant's design claim.

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The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JERRY SMITH	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JAMES T. MOORE	)	
Administrative Patent Judge	)	

ICC/lbg

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